

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

2. **PREMATURE FINAL REJECTION**

For the following reasons, Applicant deems the Final Rejection to be premature and therefore respectfully requests withdrawal of the finality of the rejection.

The examiner's action will be complete as to all matters MPEP § 707.07

Where the applicant traverses any rejection, the Examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. MPEP § 707.07(f).

In the Final Rejection of January 25, 2008, the Office maintained a rejection originally issued in the Office Action of May 30, 2007. The original rejection was of Claims 1, 3 and 6-25 under 35 U.S.C § 103(a) as being unpatentable over Pricescan in view of U.S. patent no. 6,594,666 ("Biswas"). In its Response of August 30, 2007, Applicant pointed out that the rejection of the independent claims is improperly maintained because the Examiner relies on page 4 of "Pricescan" as teaching or suggesting the claim element "distinguishing online providers from offline providers in said integrated list." Applicant pointed out that, while page 4 of Pricescan mentions the inclusion of brick-and-mortar retailers in an integrated listing, there is no teaching or suggestion of distinguishing between them in the integrated directory.

The Examiner contended that "Pricescan" inherently teaches the claim language. Applicant traversed the finding that the combination inherently teaches all elements of the claimed subject matter, pointing out that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 (IV), quoting *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993).

Additionally, Applicant pointed out that, to establish inherency, extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing

described in the reference” . MPEP § 2112 (IV) quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

Applicant finally noted that the Examiner had provided no rationale or extrinsic evidence that the system described in Pricescan must necessarily describe the subject matter of claim Claims 1 and that Pricescan accordingly contained no teaching or suggestion of the feature.

The Examiner maintains the rejection, citing additional evidence from Pricescan in support of his finding that Pricescan inherently teaches the claimed feature. The Examiner additionally relies on page 12 of Pricescan as displaying a radio button allowing a user to sort items by price and then by a list of available stores. Applicant notes, as described below, that page 12 of Pricescan does not contain such a feature. Even if the reference did contain such a feature, the Examiner has failed to make the required showing that Pricescan necessarily includes the claimed subject matter, merely asserting, incorrectly, that Pricescan allows a user to distinguish an online provider from an offline provider with a store; further asserting that it would be inherent in Pricescan to distinguish between online and offline providers in order to determine the best method of purchasing goods. Even though the Examiner has cited additional intrinsic evidence, he has not shown that Pricescan necessarily includes the claimed subject matter. At best, he has only shown that Pricescan could include the feature. Applicant specifically requested in its traverse of August 30, 2008 that the Examiner make such showing.

Because the Examiner has failed to make the required showing, the issue remains open. Thus, the Examiner has failed to adequately respond to the substance of Applicant's previous arguments. Accordingly, the present rejection is not complete as to all matters. Finality of the present rejection is therefore deemed premature and should be withdrawn.

3. **35 U.S.C § 103**

Under *Graham*, establishment of a *prima facie* case of obviousness requires resolution of the following factors:

1. the scope and content of the prior art;
2. the level of ordinary skill in the art;

3. the differences between the claimed invention and the prior art; and
4. objective evidence of nonobviousness.

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).

5 Claims 1, 3 and 6-25 stand rejected as being unpatentable over Pricscan in view of U.S. patent no. 6,594,666 ("Biswas"). Applicant respectfully disagrees. The Examiner relies on Pricscan, page 4 as teaching or suggesting the claim element "distinguishing online providers from offline providers in said integrated list," contending that, although there is no explicit teaching in the combination of the claim element,
10 Pricscan, page 4, inherently teaches the claim element.

 The relevant teaching from Pricscan is a Q&A segment answering the question "Does a vendor need to have a web site to be included in the shopping guide?" The answer relates that product and pricing information is gathered on a daily basis and entered into a searchable database, which is updated daily. While the foregoing
15 language may imply that both online and exclusively brick-and mortar retailers are both listed in the shopping guide, there is no teaching that the shopping guide provides any way of distinguishing between online and brick-and mortar retailers.

 Applicant has diligently searched pages 5-12 of Pricscan and can find no teaching to suggest that Pricscan distinguishes online retailers from brick-and-mortar
20 retailers. Thus, the contention that Pricscan inherently teaches the claim limitation appears to be based on the Examiner's conclusion that Pricscan could include the claim feature.

 The Examiner additionally relies on page 12 of Pricscan in support of his finding that Pricscan inherently teaches the claimed subject matter, asserting that page 12 of
25 Pricscan displays a radio button allowing a user to sort items by price and then by a list of available stores. Applicant first notes that it has diligently searched Pricscan and can find no such element in the depicted in the user interface.

 Applicant notes that page 12 of Pricscan shows a pulldown menu, in the upper-right hand corner of the page, bearing the legend "Find a store." Accordingly, it is
30 incorrect that Pricscan includes a radio button that allows the user to sort items by a list of available stores. Applicant next notes that the pulldown menu, erroneously

described as a "radio button" by the Examiner does not allow the user to sort items by a list of available stores.

Applicant respectfully invites the Examiner to visit the archived copy of the Pricescan website and interact with the particular feature. If he were to do so, he would
5 find that the pulldown list bearing the legend "Find a store" is merely a sponsored list of retailers, organized according to product category. Thus, it is incorrect that Pricescan provides the capability of sorting items by a list of available stores. Even if it were correct that Pricescan provides such sorting ability, the list of retailers does not distinguish between online retailers and brick-and-mortar retailers. The word "stores" in
10 the legend is thus used figuratively, being applied to any retailer, whether they are a brick-and-mortar retailer or not.

Even if it were correct that Pricescan provided the capability of sorting items by available stores, the fact remains that the Examiner has failed to make a showing, discussed above, that Pricescan must necessarily contain the claimed feature.
15 Accordingly, there is no teaching or suggestion of the claim feature in Pricescan.

Biswas, describing a location-aware application development framework, adds nothing to Pricescan. Therefore, the combination of Pricescan and Biswas fails to teach or suggest:

"A computer-implemented method for providing an integrated electronic list of
20 providers, comprising the steps of:

- determining at least one online provider for an item;
- determining at least one offline provider for the item;
- wherein the determining steps follow a request for a product;
- wherein when the request is for a desired geographical area, a user may choose
25 one of several target locations, which have been previously created and stored;

- wherein when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location; and

- integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item; and

- 30 distinguishing online providers from offline providers in said integrated list."

As such, the combination fails to teach or suggest all elements of the claimed invention. The Examiner has therefore failed to correctly assess the scope and content of the prior art. Because the Examiner's understanding of the scope and content of the prior art is flawed, his analysis of the difference between the claimed subject matter and the prior art is necessarily flawed.

Applicant also notes that the present rejection completely fails to address the second of the *Graham* factors: resolution of the level of ordinary skill in the art. Because the Examiner has failed to resolve the level of ordinary skill in the art, any assertions of what would be obvious to the ordinarily-skilled practitioner are merely conclusory statements by the Examiner, lacking any evidentiary basis.

Thus, because the Examiner has failed to correctly resolve the *Graham* factors, no *prima facie* case of obviousness has been established. The present rejection is therefore deemed improper.

The foregoing remarks apply equally to claims 22 and 23.

In view of their dependence from allowable parent claims, the dependent claims are deemed allowable without any separate consideration of their merits.

For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

In view of the foregoing, the Application is deemed to be in allowable condition. Accordingly, Applicant seeks favorable reconsideration and prompt allowance of the claims. Should the Examiner find it helpful, he is encouraged to contact applicant's attorney at 650-474-8400.

Respectfully submitted,



Michael A. Glenn
Reg. No. 30,176

Customer No. 22,862